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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/069,981

03/14/2002

Florence L'Allouet

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01/22/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.

1940 DUKE STREET

ALEXANDRIA, VA 22314

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,981

Examiner

Dr. Kelechi C. Egwim

Applicant(s)

L'ALLORET, FLORENCE

Art Unit

1713

— The **MAILING DATE** of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONEO (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-48 is/are pending in the application.
- 4a) Of the above claim(s) 27, 31, 34, 35, 37, 38 and 46-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25, 26, 28-30, 32, 33, 36 and 39-45 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 053002.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, species Aa, Ba and Cb, claims 25, 26, 28-30, 32, 33, 36, and 39-45 in Paper No. 112003 is acknowledged. The traversal is on the ground(s) that "the references (EP 583814 and EP 629649) do not teach the limitations of claim 25. This is not found persuasive because the limitations of claim 25 are anticipated by or obvious over several other prior art documents, as cited in the rejections below.

Applicant further asserts that the Examiner has not applied the same PCT standard as the International Authority, since no determination of lack of unity was made during the International stage of prosecution. However, the Applicant is reminded that a finding of lack of unity can be made at anytime during prosecution, including the National stage and that this is not, alone, evidence of secondary standards. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features since the technical feature which links the claims (see claim 25) is anticipated by or obvious over the prior art.

Further, the species of the species restriction are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 because, pursuant to PCT Rule 13.2 and PCT Administrative Instructions, Annex B, Part 1(f)(1)(B)(2), the species are not art recognized equivalents

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 27, 31, 34, 35, 37, 38 and 46-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim.

Claim Objections

3. Claim 30 is objected to because of the following informalities: The period is missing from the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29, 30, 33, 36, 39, 41, 42, 44 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Regarding claims 29, 30, 33, 36, 39, 41, 42, 44 and 45, the phrases "possibly being", "such as", "especially", "preferably" and "may be" render the claims indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 25, 26, 28, 30, 32, 33, 36 and 39-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Merchant Jr. et al. (USPN 4,737,265), Yamamoto et al. (USPN 4,839,167) or Breneman et al. (USPN 5,338,352)

Each of Merchant Jr. et al. (col. 3, lines 39-50, col. 5, lines 33-66 and col. 6, lines 33-49), Yamamoto et al. (col. 2, lines 10-46 and col. 4, line 45-47) and Breneman et al. (col. 2, lines 10-16, col. 6, lines 34-67 and col. 7, lines 25-33) teach oil-in-water dispersions comprising, in the aqueous phase, a water-soluble polymer having units resulting in an LCST (lower critical solution temperature or cloud point) within the range recited in the present claims, wherein the water-soluble/LCST units are among the units recited in the present claims.

Thus, the requirements for rejection 35 U.S.C. 102(b) have been met.

9. Claims 25, 26, 28-30, 32, 33, 36 and 39-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Ezaki et al. (JP 61245835), Koerner et al. (USPN 4,274,977), Fogel et al. (USPN 4,559,226) or Yabuta et al. (EP 1055694)

Each of Ezaki et al. (See abstract), Koerner et al. (col. 2, lines 13-18, col. 6, lines 24-28 and the examples), Fogel et al. (col. 1, lines 10-13, col. 4, lines 46-48, col. 5, lines

63-66 and col. 7, lines 45-48) and Yabuta et al. (page ¶ 14 and page 11, ¶ 97 and 100) teach oil-in-water dispersion comprising, in the aqueous phase, a water-soluble polymer having unit resulting in an LCST (lower critical solution temperature or cloud point) within the range recited in the present claims, wherein the water-soluble/LCST units are among the units recited in the present claims.

Thus, the requirements for rejection 35 U.S.C. 102(b) have been met.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

KCE

